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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,738	09/08/2000	Junji Otani	NV/P-22090/A	3187

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/657,738

Applicant(s)

OTANI ET AL.

Examiner

Marie R. Yamnitzky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003 and 03 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 12 and 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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1. This Office action is in response to applicants' amendment filed November 04, 2002, and the elections filed April 28, 2003, August 27, 2003 and September 03, 2003.

Claims 1-3, 7 and 12-21 are pending.

2. Application No. 09/735,080 (now U.S. Patent No. 6,603,020 B1) is withdrawn as prior art under 35 U.S.C. 102(e)/103(a) in view of the fact that applicants' foreign priority application, filed prior to the filing date of the '080 application, is of record, is in English, and sufficiently supports the present claims such that the '080 application does not constitute prior art.

3. Applicants' election without traverse, in Paper Nos. 11, 13 and 14, of Group II (claims 7 and 13-17) and the species of formula I in which each of R_1 and R_2 is C_{1-25} alkyl and each of Ar_1 and Ar_2 is substituted or unsubstituted naphthyl is acknowledged. Claims 7 and 13 read on the elected species. Applicants have selected the compound represented by formula I in which each of R_1 and R_2 is methyl and each of Ar_1 and Ar_2 is unsubstituted 1-naphthyl as the ultimate species to be used as the starting point for further search and examination. The ultimate species is the compound represented by the ninth formula shown in claim 13.

Claims 1-3, 12 and 18-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

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Claims 14-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 13 and 14.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the alternative definition of R_5 , R_6 and R_7 which begins at page 12, line 8 of the amendment received November 04, 2002 (Paper No. 8), reference is made to "the aryl" (p. 12, l. 10 of Paper No. 8). It is not clear what "the aryl" refers to.

Page 12, line 14 recites " n stands for 0, 1, 2 or 3". It is not clear if this definition pertains both to the subscript " n " that appears in the fifth line from the bottom of page 11 of Paper No. 8 and the subscript " n " that appears in the 15th line on page 12.

It is not clear if the subscript " m " that appears in the penultimate line on page 11 of Paper No. 8 has the definition set forth in line 7 on page 11.

Claim 7 sets forth a formula for a phenyl group as a possibility for Ar_1 and Ar_2 of formula III followed by a definition of R_5 , R_6 and R_7 , but there is no R_5 shown in the formula.

For the possibilities set forth in the last three lines of claim 7, it is not clear if R_8 , R_9 , R_{10} and n have the same definitions as set forth earlier in the claim, and if R_6 and R_7 have the same proviso as set forth earlier in the claim.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jost et al. (4,585,878).

Jost et al. generically disclose N-substituted diketopyrrolopyrroles encompassing compounds within the scope of present claims 7 and 13. For example, see column 1, line 5-c. 4, l. 68. With respect to R₁ and R₂ in Jost's formula (I), Jost teaches that phenyl or naphthyl which are unsubstituted or which carry substituents that do not confer solubility in water are of particular interest (see c. 4, l. 63-c. 5, l. 40). With respect to R₃ and R₄ in Jost's formula (I), alkyl groups having 1-12 carbon atoms, and benzyl which may be substituted by halogen or by alkyl groups having 1-12 carbon atoms are among the preferences taught by Jost (see c. 5, l. 41-47). As taught at c. 9, l. 30, Jost's compounds are fluorescent.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to make various compounds within the scope of Jost's formula (I) in order to provide compounds useful for Jost's purposes. One of ordinary skill in the art would have reasonably expected that compounds within Jost's formula (I), and particularly those having the preferred groups taught by Jost, would be useful for Jost's purposes. It is the examiner's position that compounds within the scope of present claims 7 and 13 would have been *prima facie*

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obvious to one of ordinary skill in the art at the time of the invention given Jost's disclosure because these compounds have preferred groups taught by Jost. For example, the first formula in claim 13 represents a compound of Jost's formula (I) wherein R_1 and R_2 are radicals of formula (III) as shown at c. 5, l. 24-40 wherein R_{23} is a C_1 -alkyl and R_{22} is hydrogen, and R_3 and R_4 are each benzyl substituted by C_1 -alkyl. As another example, the ninth formula in claim 13, which is also within the scope of the formula I as defined in claim 7, represents a compound of Jost's formula (I) wherein R_1 and R_2 are each unsubstituted naphthyl, and R_3 and R_4 are each C_1 -alkyl.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 7 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4 and 5 of U.S. Patent No. 6,603,020

B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is substantial overlap between the fluorescent diketopyrrolopyrroles of the present claims and the fluorescent diketopyrrolopyrroles of the patented claims.

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9. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for Art Unit 1774 is (703) 872-9306 for all official faxes.
(Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (703) 872-9041.)

MRY
November 17, 2003

Marie R. Yamnitzky

MARIE YAMNITZKY
PRIMARY EXAMINER

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